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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
KAU, STEVEN Y				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/621,448

Applicant(s)

OHISHI ET AL.

Examiner

STEVEN KAU

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 and 13-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Continued Examination Under 37 CFR 1.114: A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 6, 2008 has been entered.

Response to Arguments

2. This action is responsive to the following communication: an Amendment filed on February 8, 2008.

- Claim 12 has been cancelled, claims 1, 22 and 23 have been amended and claims 1-11 and 13-23 are currently pending.
- Applicant's arguments, "Rejection Under 35 U.S.C. § 112, first paragraph", pages 8-9, 2/8/2008, with respect to claims 1-11 and 13-23 have been fully considered and are persuasive. The rejection of claims 1-11 and 13-23 under 35 U.S.C. § 112 first Paragraph has been withdrawn.

Applicant's arguments with respect to Claims 1-11 and 13-23 have been fully considered but are persuasive. The Examiner has thoroughly reviewed Applicant's arguments but firmly believes that the cited references are reasonably and properly meeting the claimed limitations.

Applicant's arguments, "However, Matsushima does not describe or suggest an application launch part configured to access launch selection information, the launch selection information indicating at least a location of an auxiliary storage device that stores one or more applications, and configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information, where the service modules are stored in a memory distinct from the auxiliary storage device, as is recited in Claim 1" (page 10, Remarks/Argument, 2/8/2008).

In re, the Examiner disagrees with the conclusion. Matsushima discloses "an application launch part (**Command Dispatcher Module 129b of Fig. 10**) configured to access launch selection information (e.g. **"the dispatch module 129b selects the reprint application"** implies that the application launch part, or the dispatch module 129b must accesses the launch selection information to select reprint application, Para. 0113), the launch selection information indicating at least a location of an auxiliary storage device (e.g. **information in MCS 125 and NCS 128 of Fig. 10 indicates or controls transferring data stored in HDD 102 or the memory to the computer at the network, etc., Para. 0096-0097**) that stores one or more applications (e.g. **reprint application, & detail operation of Fig.12**), and configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information, where the service modules are stored in a memory distinct from the auxiliary storage device (e.g. **service modules such Basic common services of System Control Service (SCS) 122, System Resources Manager (SRM**

123, and ECS 124, Memory Control Service (MCS) 125 of Fig. 10 are stored in the multifunction device storage device, which is distinct from the network storage device, Para; 0070 & 0112), as is recited in Claim 1."

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner also references the applicant to the claims rejection section below for the explanation on how the prior art references read on the amended claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11 and 13-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With respect claim 1, recites, "An image forming apparatus that includes service modules for performing system side processes on image formation, wherein applications can be added to the image forming apparatus separately from the service modules, the image forming apparatus comprising: an application launch part configured to access launch selection information, the launch selection information

indicating at least a location of an auxiliary storage device that stores one or more applications, and configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information, wherein the service modules are stored in a memory distinct from the auxiliary storage device" (emphasis added by applicants). This claimed subject matter does not enable one ordinary skilled in the art to conduct or perform the invention according to the specification. For instance, having an application launch part configured to access launch selection information, and the launch selection information indicates one or more auxiliary memory, which contains one or more application, and service modules are stored in a memory distinct from the auxiliary storage device. However, one skilled in the art does not know under what condition(s) an application launch part would access the launch selection part and adding application(s) to the image forming apparatus. According to the First Embodiment of the specification, one of the important conditions is that external application can be installed to HDD under the condition when the diagnosis result of HDD is normal and the platform 120 includes control services for interpreting a process request from an application to issues an acquiring request, and so on (Pars. 0039-0045, US 2004/0057074).

Matsushima' 54397 also teaches the control of data transferring. For instance, Matsushima' 54397 teaches an HTTP analyzing module analyzing the contents of HTTP command data inputted from the external device via the network (Figs. 7 & 10, & Pars. 0015 & 0060).

Claims 22 and 23 are rejected under 35 U.S.C. 112 first paragraph for the same reason as discussed in above.

Claims 2-11 and 13-21 are rejected under 35 U.S.C. 112 first paragraph because they are dependent claims of claims 1 and 22, respectively.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 and 13-23 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that claims 1, 22 and 23 fail to correspond in scope with that which applicant(s) regard as the invention can be found in the specification filed July 18, 2003. In that paper, applicants have stated "The external application launch part 131 launches the external application 117 installed in the HDD 103 if the result of the diagnoses of the HDD 103 is normal" and "The platform 120 includes control services for interpreting a process request from an application to issue an acquiring request for the hardware resources, etc. " (Pars 0041 and 0044, US 2004/0057074), and this statement indicates that the invention is different from what is defined in the claims 1, 22 and 23. Claims 2-11 and 13-21 are rejected under 35 U.S.C. 112 second paragraph because they are dependent claims of claims 1 and 22, respectively.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1- 9, 11 and 13-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsushima (US 2002/0054397).

Regarding Claim 1.

Matsushima discloses an image forming apparatus (**Digital Multifunction Device 1 of Fig. 1 and Multifunction Device 100 of Fig. 10**) that includes service modules (e.g. **Basic common services of System Control Service (SCS) 122, System Resources Manager (SRM) 123, and ECS 124, Memory Control Service (MCS) 125 of Fig. 10, Par. 0070**) for performing system side processes on image formation, wherein applications can be added to the image forming apparatus separately from the service modules (**installing a program in HDD 15 from a CD-ROM, Para. 0047**), the image forming apparatus comprising: an application launch part (**Command Dispatcher Module 129b of Fig. 10**) configured to access launch selection information (e.g. **launch selection information must include memory and/or network address which is controlled by Memory Control Service (MCS 125 of Fig. 10), Network Control Service (NCS 128 of Fig. 10) and application available based on the analysis of XML syntax analyzing module 129e of Fig. 10, and then selects the corresponding application, Para 0096-0097**), the launch selection information

indicating at least a location of an auxiliary storage device (e.g. **information in MCS 125 and NCS 128 of Fig. 10 indicate or control transferring data stored in HDD 102 or the memory to the computer at the network, etc., Para. 0096-0097**) that stores one or more applications (e.g. **reprint application, & detail operation of Fig.12**), and configured to launch the one or more applications (e.g. **a reprint application, Para. 0103**) from the auxiliary storage device (e.g. **“the multifunction device 100 receives HTTP data from the network interface 103”** implies that there must be a network storage device, or an auxiliary memory device, Para. 0112) according to the accessed launch selection information (e.g. **“the dispatch module 129b selects the reprint application”** implies that the application launch part, or the dispatch module 129b must accesses the launch selection information to select reprint application, Para. 0113), wherein the service modules are stored in a memory distinct from the auxiliary storage device (e.g. service modules such Basic common services of System Control Service (SCS) 122, System Resources Manager (SRM) 123, and ECS 124, Memory Control Service (MCS) 125 of Fig. 10 are stored in the multifunction device storage device, which is distinct from the network storage device, Para; 0070 & 0112).

The scope of the claim: This is an apparatus utility claim and it claims a software module, an application launch part, which is configured to access launch selection information and the launch selection information indicates at least a location of auxiliary storage device that stores one or more applications, where the service modules are stored in a memory distinct from the auxiliary

storage device. As discussed in the above In re, the scope of the claim is anticipated by Matsushima as discussed in the claim rejection above, and therefore, the instant invention is not new or not novel.

Regarding Claim 2.

Matsushima discloses wherein the auxiliary storage device is at least one of a hard disk device (**e.g. CD-ROM Drive 16 of Fig. 2**), a recording medium removable from the image forming apparatus without disassembling any other portion of the image forming apparatus (**CD-ROM is removable and no disassembling any other portion of the image forming apparatus, Fig. 2, Pars 0047 & 0048**), and a computer connected to the image forming apparatus via a network (**Pars 0097 & 0098**).

Regarding Claim 3.

Matsushima discloses the image forming apparatus further comprising: a part for displaying a setting screen for setting the launch selection information on a display part of the image forming apparatus, and storing information input from the setting screen as the launch selection information (**Para. 0012**).

Regarding Claim 4.

Matsushima discloses wherein the application launch part (**Command Dispatcher Module 129b of Fig. 10**) launches the application by referring to information on the application (**Para. 0096**).

Regarding Claim 5.

Matsushima discloses wherein the information referred to by the application launch part is address information of the application (**e.g. a reprint application**

through HTTP request must through address information for obtaining the correct reprint job requisition, Para 0102).

Regarding Claim 6.

Matsushima discloses wherein the application launch part determines whether the application is installed at the location according to presence or absence of predetermined information on the application, and the application launch part launches the application if the application is installed at the location (**Matsushima discloses a process procedure for dispatching an application based on results of analysis by the XML syntax analyzing module 129c, Pars 0094, 0095 and 0096).**

Regarding Claim 7.

Matsushima discloses wherein the application launch part refers to setting information including information indicating whether a predetermined application is to be launched, and the application launch part launches the predetermined application if the setting information includes information indicating the predetermined application is to be launched (**e.g. dispatching and or downloading predetermined programs, pars 0047 & 0048).**

Regarding Claim 8.

Matsushima discloses wherein the application launch part refers to setting information including information indicating applications to be launched, and the application launch part launches the application indicated in the information (**e.g. setting information stored in the flash memory, Para 0055).**

Regarding Claim 9.

Matsushima discloses a part for displaying a setting screen for setting the setting information on a display part of the image forming apparatus (**Pars 0073 & 0080**), and storing information input from the setting screen as the setting information (**Pars 0073 & 0080**).

Regarding Claim 11.

Matsushima discloses wherein the image forming apparatus receives an application from the computer connected to the image forming apparatus via a network by using an http protocol or an ftp protocol, and the application launch part launches the received application (**Pars. 0041 & 0097**).

Regarding Claim 22.

Claim 1 recites identical features as claim 22, except claim 22 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 22.

Regarding Claim 23.

Claims 1 & 2 recite identical features as claim 23. Thus, arguments similar to that presented above for claims 1 & 2 are also equally applicable to claim 23.

Regarding Claim 13.

Claim 2 recites identical features as claim 13, except claim 13 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 13.

Regarding Claim 14.

Claim 3 recites identical features as claim 14, except claim 14 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 14.

Regarding Claim 15.

Claim 4 recites identical features as claim 15, except claim 15 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 15.

Regarding Claim 16.

Claim 5 recites identical features as claim 16, except claim 16 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 16.

Regarding Claim 17.

Claim 6 recites identical features as claim 17, except claim 17 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 17.

Regarding Claim 18.

Claim 7 recites identical features as claim 18, except claim 18 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 18.

Regarding Claim 19.

Claim 8 recites identical features as claim 19, except claim 19 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 19.

Regarding Claim 20.

Claim 9 recites identical features as claim 20, except claim 20 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 20.

Regarding Claim 21.

Claim 11 recites identical features as claim 21, except claim 21 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 11 are also equally applicable to claim 21.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushima (US 2002/0054397) in view of Kimura (US 6,226,097).

Regarding Claim 10.

Matsushima differs from claim 10, in that he does not teach that the image forming apparatus further comprising a virtual application service that operates as a client process for the services modules and operates as a server process for the applications, wherein the virtual application service includes the application launch part.

Kimura discloses a print interrupt method, in that he teaches the image forming apparatus further comprising a virtual application service (**e.g. a virtual server/virtual print spooler/virtual print server provide virtual application services; Figures 1, 7 & 8 col 6, lines 4-13**) that operates as a client process for the services modules (**Figures 7 & 10, col 6, lines 1-13 & col 7, lines 13-38**) and operates as a server process for the applications, wherein the virtual application service includes the application launch part (**e.g. execute various types of programs such as application; Figure 1, col 4, lines 15- 36**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Morita to include the image forming apparatus further comprising a virtual application service that operates as a client process for the services modules and operates as a server process for the applications, wherein the virtual application service includes the application launch part taught by Kimura because it is capable of continuing normal printing even if a user request interruption of data transmission and performs the next printing (**col 1, lines 43-46**).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/S. Kau/
Examiner, Art Unit 2625
5/16/2008

/King Y. Poon/
Supervisory Patent Examiner, Art
Unit 2625